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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/540,528	05/18/2006	Hisashi Maeshima	3273-0207PUS1	5366
2292 7590 07/28/2010 BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747				
EXAMINER MOORE, MARGARET G				
ART UNIT		PAPER NUMBER		
1796				
NOTIFICATION DATE		DELIVERY MODE		
07/28/2010		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

Office Action Summary

Application No.

10/540,528

Applicant(s)

MAESHIMA, HISASHI

Examiner

Margaret G. Moore

Art Unit

1796

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 March 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 to 3, 11 to 23 is/are pending in the application.
- 4a) Of the above claim(s) 1, 2, 11 and 13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3, 12, 14, 15, 21 and 22 is/are rejected.
- 7) ☒ Claim(s) 16 to 20, 23 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 3/3/2010 has been entered.
2. Please note that this application has been transferred and is currently under examination by Examiner Margaret Moore. Applicants' representative and the examiner had an interview on 3/29/10 to discuss the status of the claims and rejections. The Examiner noted at that time that applicants would receive an office action in response to the amendment and arguments filed with the RCE of 3/3/2010.
3. Claims 16 to 19 and 23 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim cannot depend upon another multiple dependent claim. Note that claim 16 depends upon claims 14 or 15, which are multiple dependent claims. See MPEP § 608.01(n). Accordingly, the claims have not been further treated on the merits.

The Examiner notes that, had new claim 23 been treated on the merits, the Examiner would have rejected this claim as containing new matter. The Examiner cannot find support for "optically homogenous" in the specification. The Examiner points this out at this time to aid applicants in their response.
4. Claim 20 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The alicyclic epoxy compound (a') is not within the scope of the general formula (1) found in claim 3. Note that "m" is required to be 2 to 10 while "n" is 3 to 10. There are not 2 to 10 "n" units in

the epoxy compound found in claim 20. As such this claim is not further limiting and is, in face, outside of the scope of claim 3.

The Examiner notes that had claim 20 been treated on the merits, the Examiner would have rejected this claim under 35 USC 112. Please note that this claim contains the trademark/trade name CEL2081. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. The Examiner notes this at this time to aid applicants in their response.

5. In view of the above, only claims 3, 12, 14, 15, 21 and 22 are currently under examination.

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 3, 12, 14, 15, 21 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fujiwa et al. in view of Takai.

Fujiwa et al. teach a composition comprising a alicyclic epoxy compound. Please see the general formula of the epoxidized alicyclic compound on column 9, lines 5 and on. Particular attention is directed to the specific compound on the top of column 24 which shows an epoxy compound meeting the claimed general formula in claim 3, having a corresponding "m" value of approximately 10 and a corresponding "n" value of

5. This epoxy compound is admixed with a cationic polymerization initiator. See column 14, lines 15 and on. Note column 20, lines 45 and on, which teach heating during curing. As such this composition can be considered to be heat curable. There is also a post curing step taught which also meets the requirement of heat curable. This differs from that claimed in that it does not contain a surfactant (e) as claimed.

Takai teaches a similar alicyclic epoxy composition that cures in the presence of a cationic polymerization initiator. Paragraph 160 and on teaches the addition of lubricity imparting agents for improving the lubricating property of a coating film prepared therefrom. Paragraph 164 specifically refers to various silicones including BYK 300¹ which meets the requirement of a silicon based surfactant having a polydimethylsiloxane skeleton. Paragraph 164 also teaches the addition of fluorine waxes, which meet the requirement of a fluorine based surfactant.

One having ordinary skill in the art would have been motivated by the teachings of Takai to add a lubricity imparting agent to the composition of Fujiwa et al. in an effort to improve the lubricating properties thereof. Applicants are merely adding a known compound to a known composition to obtain the benefits and properties thereof. In this manner claim 3 is rendered obvious.

For claim 12, please see paragraph 166 in Takai which teaches these amounts.

For claim 22, please note that applicants' specification teaches that silanol based cationic catalysts such as triphenyl silanol can be used as a cationic catalyst that generated cationic species by heat. Fujiwa et al. teach various catalysts that generate a silanol group including various triphenyl species that will generate a silanol group to form triphenyl silanol. See for instance Application Example 6 and column 15, lines 26 to 27.

8. Claims 3, 12, 14, 21 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marutani et al.

¹ Please see column 15 on Bacon.

Marutani et al. teach an alicyclic epoxy oligomer composition in which an alicyclic epoxy compound and a cationic polymerization catalyst are combined. The bottom of column 11 teaches various alicyclic epoxy compounds meeting the general formula (1) in claim 3. Also see the polyester oligomer having an alicyclic epoxy group prepared from monomer F in Table 7 (P8). Since R¹ and R² allow for the presence of an ester group this also meets the general formula (1). Various heat potential cationic polymerization catalysts are taught on column 24, lines 50 and on, through column 25. Furthermore the bottom of column 26 teaches, as a preferred leveling agent, KF 96 which is a dimethyl silicone fluid².

One having ordinary skill in the art would have been motivated to select an epoxy meeting general formula (1) in claim 1 in combination with a heat generating cationic catalyst and a silicone leveling agent from the teachings in Marutani et al. As such the skilled artisan would have found such a claimed composition to have been obvious.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret G. Moore whose telephone number is 571-272-1090. The examiner can normally be reached on Monday and Wednesday to Friday, 10am to 4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

² See the Shin Etsu silicone fluid data sheet provided.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Margaret G. Moore/
Primary Examiner, Art Unit 1796

mgm
3/31/10